



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------------|------------------------|
| 10/565,171 | 01/19/2006 | Mori Nagayama | 040302-0540 | 7246 |
| 22428 7590 05/23/2008 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007 | | | EXAMINER WANG, EUGENIA | |
| | | | ART UNIT 1795 | PAPER NUMBER |
| | | | MAIL DATE 05/23/2008 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/565,171

Applicant(s)

NAGAYAMA ET AL.

Examiner

EUGENIA WANG

Art Unit

1795

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 May 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
 Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 03 April 2008. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1-14.
 Claim(s) withdrawn from consideration: 15-43.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
 12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). 5/9/08
 13. ☐ Other: _____.

/Gregg Cantelmo/
Primary Examiner, Art Unit 1795

Continuation of 3. NOTE: Applicant argues that the changes to claims 1, 14, 9, and 11 do not change the scope of the claims. Examiner respectfully disagrees. The reasons are set forth below.

With respect to claim 1, Applicant argues that the incorporation of previously pending claim 2 into claim 1 does not change the scope of the claims.

Examiner respectfully disagrees, because, the addition of the limitations previously pending claim 2 does change the scope of the claims. It changes the scope of all of the claims that were previously only dependent on the limitations of claim 1 (such as claims 7, 8, and 13). Therefore, it is seen that the incorporation of the previously pending claim 2 into claim 1 does change the scope of the claims, as some of the dependent claims are subject to limitations not previously required. Therefore, such a change would require further search and consideration.

With respect to claim 14, Applicant argues that the incorporation of the limitations of claim 15 into claim 14 does not change the scope of the claims.

Examiner respectfully disagrees. Claim 15 was previously withdrawn. Incorporating a previously withdrawn claim into a previously examined claim most definitely changes the scope of claim 14. Whether or not the claim will be withdrawn or not would require further consideration. If it were to be examined, looking for informality issues as well as 112s would also require further consideration.

Applicant argues that claims 9 and 11 have been placed in an independent form (and include all of the limitations of previously examined claim 1) and thus does not change the scope of the claims.

This may be true for these claims, however, as listed above, the changes claims 1 and 14 do change the scope of the claims and would already require further consideration. Therefore, the amendments have not been entered.

With respect to the listing of KR 2001-0072835A, Applicant argues that WO 00/10736 is an English language document in the same family, and thus serves as the English translation of KR 2001-0072835A.

Examiner finds this argument persuasive. The provided Information Disclosure Statement is included with the KR 2001-0072835A being considered. (Note: The other two references are crossed out, as they are duplicates of cited prior art that have already been considered.)